

REMARKS

Claims 1-22 remain pending in this application. Claims 1, 8, and 14 are independent. No claims have been amended, added, or canceled by this Amendment.

No new matter is involved with the Specification amendment which has been made merely to correct a minor typographical error in the figure number discussed in paragraph [0042] of the Specification.

Obviousness-Type Double Patenting Rejection over US 6,870,822

Withdrawal of the rejection of claims 1, 2, 8, 9, 14, and 15 over claims 1, 5-9, 13, 20, and 21 of commonly owned US Patent 6,870,822 under the judicially-created doctrine of obviousness-type double patenting is requested.

An obviousness-type double patenting rejection rests on the prohibition against issuance of a second patent that would continue protection beyond the expiration date of the reference patent of a mere variation of the first-patented invention that would have been obvious to those of ordinary skill in the relevant art. *Such a rejection must include clear evidence* to establish why an alleged variation of an invention claimed in a prior patent would have been obvious.

To establish a *prima facie* case of nonstatutory-type double patenting, the Examiner must first identify the inventions recited in the claims under consideration and in the reference patent claims. Next, the Examiner must establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person having ordinary skill in the art. Based upon long-settled patent law, the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), with analysis focusing on the *claims* of the reference patent, and *not* upon its disclosure. After the Examiner has provided such a claim analysis in light of the prior patent claims, the burden of proof then would shift to the Applicant to rebut the *prima facie* case.¹

¹ See *In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985).

However, the Examiner has *not* made a *prima facie* case for obviousness-type double patenting because *analysis on a claim-by-claim basis has not been presented*. The Examiner merely states in a conclusory fashion that claims 1, 2, 8, 9, 14, and 15 of the present application are rejected over claims 1, 5-9, 13, 20, and 21 of Applicant's own U.S. Patent 6,870,822 to Balogh ("Balogh '822") allegedly, "since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent." (See p. 3, ¶ IV. of the Official Action).

The Examiner failed to articulate any technical basis for her conclusion, except to assert that "[t]he subject matter go in the instant application is fully disclosed in the patent and is covered by the patent since the patent in the application are claiming common subject matter, as follows...." The Examiner goes on to list various limitations in the pending claims which are not expressly or inherently recited in the issued claims of Balogh '822. This clearly is not a proper formulation of a obviousness-type double patenting rejection, since *disclosure* of subject matter claimed in the instant application and "covered by the patent" is not a proper claim-by-claim analysis, as required by MPEP §804.

Notwithstanding the deficiencies of the obviousness-type double patenting rejection as propounded by the Examiner, in the interest of expediting prosecution of this application, and without prejudice or disclaimer as to the allowability of the claims as presently presented, a Terminal Disclaimer is being submitted herewith to disclaim the term of any patent that might issue from this application beyond the patent term of Balogh '822.

Accordingly, entry of the Terminal Disclaimer and withdrawal of the obviousness-type double patenting rejection are requested.

Unpatentability Rejection over Bridges et al. in View of Sainton et al.

Withdrawal of the rejection of claims 1-3, 5, 7-10, 13-16, and 19-22 under 35 U.S.C. §103(a) as being unpatentable over Bridges et al. (US 6,148,197) in view of Sainton et al. (US 6,934,558) is requested.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Further, the prior art reference must teach or suggest all the claim limitations.² Finally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.³ The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held "[t]o facilitate review, this analysis should be made explicit."⁴ "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."⁵

Discussion of Applicant's Disclosed Embodiments

By way of background, the present application, in various embodiments, is directed to a method and apparatus for accessing a telecommunication network in which information sets describing settings needed to access networks and their resources are stored in the terminal. The terminal scans for information about available networks, and available information sets are determined by comparing the information about available networks to the stored information sets. At least one network may be accessed based on the settings defined in the available information sets.

Discussion of Bridges et al.

Bridges et al. ("Bridges") is purportedly directed to a roaming system with over the air programming which includes an apparatus for selecting a preferred wireless carrier from a

² See MPEP §2143.

³ *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

⁴ *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (see p. 14).

⁵ See *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

plurality of wireless carriers for use by a mobile station when the mobile station is roaming outside of a home market area. According to the Abstract, the apparatus appears to include a database, a generator, and a data providing device wherein the database appears to store preferred wireless carrier identities for a plurality of market areas based upon predetermined classes of service, predetermined national accounts, and a predetermined home market area. The generator appears to generate a list of preferred wireless carrier identities based upon a selected class of service, a selected national account, and a selected home market area of the mobile station. A data-providing device apparently transmits the generated list of each mobile station designated with the selected class of service, selected national account, and selected home market area.

The list of preferred wireless carriers may be based upon the roaming wireless carriers' airtime rates and services provided for each of the plurality of market areas. The generator may update the list of preferred wireless carriers when one of the carriers changes a communication characteristic such as airtime rates, and the data-providing device provides an updated list of preferred wireless carrier identities to a mobile station.

Bridges merely teaches a methodology for selecting a preferred wireless carrier when roaming outside of a home market by providing, in part, a mobile station with a list of preferred wireless carrier identities. Bridges, at col. 3:35-49, merely teaches that a user can select which band or system his PCS cellular mobile station will use when roaming.

Moreover, Bridges at col. 5:19-27 merely teaches that a list is generated for a mobile station that indicates the preferred carriers in a certain market and for a certain class of service defined for the mobile station. Finally, the passage at col. 5:50 to col. 6:3 merely explains how such a list of preferred wireless carriers is generated.

Thus, the disclosure of Bridges is limited to providing a list for the mobile station (col. 6:36-46), from which the mobile station selects a preferred carrier from a set of carriers in a list, which is actually provided to the mobile station by the generator from the network (col. 5:60-63). The selector in Bridges operates to select the preferred wireless carrier *identity*, and *not* to

The Examiner asserts in the Official Action that Sainton (at col. 18:28-36, col. 19:19-31, and 34-50, and col. 20:10-44) teaches storing network names of networks associated with the stored information sets and that network identity requests and searches for network identity responses are carried out, and at available information sets are determined by comparing the stored network names to the scanned information related to names of available networks. The Examiner's characterization of Sainton is submitted as being technically incorrect, as discussed below.

The portions of Sainton referenced by the Examiner actually relate to FIGS. 9 and 10, and disclose broadcast of system information to mobile terminals, in particular cost information, as well as information relating to signal quality, system resource and bandwidth. This received information is evaluated, and then the service provider is selected and connected based, at least in part, on user experience and satisfaction with a particular service provider.

Specific network identity requests and responses for WLAN names are not taught or suggested by Sainton and, in contrast, only the general use of broadcast mode is taught. Finally, and more to the point, *Sainton is completely silent with respect to determining the available information sets as variously disclosed and claimed by Applicant.*

Specific Deficiencies of the Combination of Bridges and Sainton

As discussed in previous communications to the Examiner, cellular systems and WLANs have their own very different protocols for operating and are thus technically different. For instance, in a WLAN, there is no specified Mobile Switching Center (MSC) and Home Location Register (HLR) as depicted in FIG. 4 of Bridge.

As explained in Applicant's specification, embodiments of the claimed invention provide a solution existing specifically in WLANs, *i.e.*, WLAN networks need to be scanned to determine their availability. Thus the claimed information sets are, in various aspects of one or more embodiments, collections of information for accessing a WLAN, for instance information as depicted in FIG. 2, and not just network identities.

As for the pending claims, the applied art, either alone or in combination, does not teach or suggest a method for accessing a wireless local area network in a telecommunications system that includes at least one terminal and a plurality of networks, wherein the method includes, among other steps, “...scanning for information related to names of available wireless local area networks using the terminal; *determining available information sets by comparing the information related to names of available wireless local area networks to the stored information sets; and accessing at least one wireless local area network based on settings described in an available information set*, wherein the storing stores network names of wireless local area networks associated with the stored information sets, the *scanning sends network identity requests and searches for network identity responses, and the determining available information sets determines the available information sets by comparing the stored network names to the scanned information related to names of available wireless local area networks*”, as recited in previously presented independent claim 1 (*emphasis added*).

Further, the applied art, either alone or in combination, does not teach or suggest a terminal that includes, among other features, “...means for storing information sets describing settings used to access wireless local area networks and their resources... determination means for *determining available information sets by comparing the information related to names of available wireless local area networks to information sets stored by the memory* means; and access means for *accessing at least one wireless local area network based on the settings described in one or more of an available information set*, wherein...the scanning means are arranged to perform the scanning *by sending network identity requests and searching for network identity responses*, and the determination means are configured to determine the available information sets *by comparing the stored network names to the scanned information identifying the names of the available wireless local area networks*”, as recited in previously presented independent claim 8 (*emphasis added*).

Finally, the applied art, either alone or in combination, does not teach or suggest a terminal that includes, among other features, “... at least one memory device configured to store information sets describing settings used to access wireless local area networks and their

determine (on the basis of any comparison) available information sets describing settings used to access wireless local area networks and their associated resources, as contemplated, claimed, and disclosed by the present application.

Thus, Bridges fails to teach or suggest storing network names of wireless local area networks in association with associated stored information sets, as required by independent claims 1, 8, and 14. Further, Bridges clearly fails to teach or suggest any scanning for information related to names of available wireless local area networks using the terminal which results in the sending of network identity requests and searches for network identity responses, as also required by each of the independent claims. Moreover, Bridges clearly does *not* determine available information sets by comparing the stored network names to the scanned information related to the names of available wireless local area networks, as also required by each of the independent claims.

At page 5 of the Official Action, the Examiner admits the above-identified deficiencies of Bridges, and offers Sainton et al. to allegedly make up for these admitted deficiencies.

Discussion of Sainton et al.

As seen in the Abstract, Sainton et al. ("Sainton") is purportedly directed to an adaptive omni-modal radio apparatus and method that appears to use a frequency agile transceiver, a digital interface circuit for interconnecting the radio transceiver with external devices, a protocol agile operating circuit for operating the radio transceiver in accordance with one of the transmission protocols as determined by a protocol signal, and an adaptive control circuit for accessing a selected wireless communication network and for generating the frequency control signal and the protocol control signal in response to a user-defined criteria. Sainton is asserted as allowing wireless service providers to broadcast electronically as part of any "handshaking" procedure with an omni-modal wireless product information such as rate information or information regarding system operating characteristics such as a percentage of system capacity and use, and/or the likelihood of being dropped.

resources...at least one determination module configured *to determine available information sets by comparing the information related to names of available wireless local area networks to information sets stored by the memory* means; and at least one access device configured to access at least one wireless local area network *based on settings described in one or more of the available information sets*, wherein...the at least one scanner is configured to perform the scanning *by sending network identity requests and searching for network identity responses*, and the at least one determination module is configured to determine the available information sets *by comparing the stored network names to the scanned information identifying the names of the available wireless local area networks*, as recited in previously presented independent claim 14 (*emphasis added*).

Accordingly, Applicant submits that the claimed invention is patentable over the teachings of Bridges and Sainton, either alone or in combination, and that independent claims 1, 8, and 14 are allowable. Reconsideration and allowance of pending claims 1-22 are respectfully requested.

Conclusion

In view of the above amendment and remarks, Applicant submits that each of pending claims 1-22 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the Undersigned Attorney is available at the telephone number indicated below.

Please charge any fees associated with the submission of this paper or during the pendency of this application to Deposit Account Number 03-3975 under order no. 060258-0277121 from which the Undersigned is authorized to draw. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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